

REMARKS**Amendment of claims 49 and 51**

Claims 49 and 51 have been amended to recite the limitation that the outdoor component is operatively attached to an immovable structure. Support for this amendment can be found at least at page 5, lines 25-30 of the originally filed specification. A building is an immovable structure.

New claims 53-60 have been added, and each of these claims depends directly or indirectly from claim 49. Support for new claims 53-60 can be found at least in original claims 1-48.

Rejection of claims 49-52 over U.S. Patent No. 5,711,701

The examiner cited column 1 of United States Patent No. 5,711,701 as allegedly anticipating claims 49-52. This rejection is traversed. The '071 patent discloses coating automotive radiators and air conditioning condensers. Claims 49 and 51 have been amended to require that the outdoor component is operatively attached to an immovable structure. Claims 49 and 51, which require that the outdoor component of an HVAC system is attached to an immovable structure distinguish over the catalytic coating of automobile components, which is discussed in the applicants' specification at page 4, lines 24-36.

Rejection of Claims 49-52 over EP 634205

In the office action, claims 49-52 were rejected as allegedly being obvious over EP634205 (abstract). Applicants respectfully traverse this rejection.

Applicants reiterate the portion of applicants' specification at page 6, lines 33-37, which emphasizes a key aspect of the claimed invention is the treatment of the atmosphere in general as opposed to treating an airstream being drawn or forced out of a confined space, such as a building. The Examiner has cited EP634205 for the teaching that an ozone decomposing catalyst can be incorporated onto equipment in air conditioning and ventilating equipment. The Examiner admits that EP634205 fails to teach that the catalyst is incorporated onto an outdoor component of the air conditioning and ventilating system, but maintains that since it is commonly recognized that the atmosphere contains ozone, it would have been obvious to

incorporate the catalyst in EP634205 onto an outdoor component of an air conditioner "because it would combat the influx of ozone into an air-conditioned residence."

Applicants respectfully point out a flaw in the Examiner's reasoning in the underlined, quoted phrase above. The abatement of ozone from the atmosphere by a catalyst borne on an **outdoor** component of an HVAC system or on a substrate added to the component **does not result in the treated atmospheric air being drawn into an air-conditioned residence.** as asserted by the Examiner. As noted in applicants' specification at page 25, the treated ambient air according to applicants' claimed invention is returned to the atmosphere, not delivered into an air-conditioned residence. Thus, modification of the EP634205 as suggested by the Examiner would destroy the intended function of the device in EP634205.

As stated in MPEP Section 2143.01, if "the proposed modification of a reference would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (quoted in MPEP Section 2143.01) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.). Thus, because the examiner's proposed modification of the system in EP634205 would result in destroying the intended function of treating the indoor air, a *prima facie* case of obviousness has not been established.

In addition, EP634205 EP634205 is directed to catalysts that are used at ambient temperatures and below, whereas in the present invention, the catalysts of the present invention work with high bulk air movement and/or elevated temperatures associated with components such as air conditioner condensers. EP634205 does not teach or suggest an apparatus that works with such components. Furthermore, applicants respectfully submit that the skilled artisan would not be motivated to move the catalysts associated with an indoor component or an automobile air conditioner to an outdoor component of an air conditioning system that is subjected to different airflow conditions, temperatures and other environmental conditions that may degrade the catalyst. Applicants respectfully request withdrawal of the rejection.

New Claims

Applicants respectfully submit that none of the features recited in new claims 53-60 are taught or suggested in the cited references.

Double Patenting Rejection

Applicants note that the undersigned was not authorized to sign the terminal disclaimer submitted on January 4, 2006. Applicants will submit a terminal disclaimer upon allowance of at least one claim in the pending application.


Conclusion

Reconsideration of the above-referenced patent application in view of the foregoing amendment is respectfully requested. A petition for a two-month extension of time is enclosed. If any other fees are due, however, the USPTO is authorized to charge Deposit Account No. 50-3329.

The undersigned was authorized by Richard A. Negin, Reg. No. 28,649, an attorney of record in the subject application, to prepare and file this Amendment on behalf of the Assignee. Correspondence should continue to be directed to Chief Patent Counsel, Engelhard Corporation, 101 Wood Avenue, P.O. Box 770, Iselin, NJ, 08830-0770.

Respectfully submitted,

Dated: June 16, 2006

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